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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,575	11/28/2003	Martin Broberg	TPP 31708	4961

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EXAMINER

GOFF II, JOHN L

ART UNIT PAPER NUMBER

1733

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/722,575	Applicant(s) BROBERG ET AL.	
	Examiner John L. Goff	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.  
     4a) Of the above claim(s) 3,5-9,18-23 and 56-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,10-12,30-47 and 50-55 is/are rejected.
- 7) ☒ Claim(s) 13-17,24-29,48 and 49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-55, drawn to a method of manufacturing a decorative laminate, classified in class 156, subclass 307.7.
  - II. Claims 56-58, drawn to a decorative laminate, classified in class 428, subclass 411.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as one without including a balance layer.

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

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This application contains claims directed to the following patentably distinct species:

**If Group I is elected applicants are required to elect one of Species I:**

Species I-A (appears to read on claim 3) directed to a particle board carrying core.

Species I-B (appears to read on claim 4) directed to a fibre board carrying core.

Species I-C (appears to read on claim 5) directed to an oriented strand board carrying core.

Species I-D (appears to read on claim 6, 8, and 9) directed to a polymer board carrying core.

Species I-E (appears to read on claim 7) directed to a fibre cement board carrying core.

The species are independent or distinct because each is a mutually exclusive and patentably distinct carrying core.

**If Group I is elected applicants are required to elect one of Species II:**

Species II-A (appears to read on claims 13-17, 24-29, 48, and 49) directed to a thermoplastic elastomer balance layer.

Species II-B (appears to read on claims 18-23) directed to a non-woven fibre arranged on a polyolefin foil balance layer.

The species are independent or distinct because each is a mutually exclusive and patentably distinct balance layer.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 10-12, 30-47, and 50-55 are generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. During a telephone conversation with Thomas Pavelko on 2/21/06 a provisional election was made with traverse to prosecute the invention of Group I, Species I-B, and Species II-A, claims 1, 2, 4, 10-17, and 24-55. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 5-9, 18-23, and 56-58 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Double Patenting***

7. Applicant is advised that should claim 44 be found allowable, claim 45 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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10. Claims 1, 2, 4, 10-12, 30-32, 37-47, and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al. (WO 02/47906) in view of Min (U.S. Patent 6,093,476) and Moebus (WO 01/21366 and see also English equivalent U.S. Patent 6,761,961).

Sjoberg et al. disclose a method of manufacturing a decorative laminate used for floor coverings comprising providing a carrying core layer, e.g. fiber board, providing a dampening foil layer of a thermoplastic elastomer on the upper side of the core layer, providing an upper decorative and abrasion resistant thermosetting laminate layer on the foil layer, and then pressing to form the decorative laminate (Page 1, lines 17-26 and Page 2, lines 12-14). Sjoberg et al. are silent as to including a balance layer on the lower side of the core layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include on the lower side of the laminate taught by Sjoberg et al. a polymer balance layer, e.g. polyvinyl chloride, as shown by Min to prevent warping of the decorative laminate.

Regarding claim 1, Sjoberg et al. do not specifically teach the decorative laminate is cut into panels and provided with edges intended for joining, it being noted Sjoberg et al. teach the decorative laminate is used for floor coverings (Page 1, lines 6-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Sjoberg et al. as modified by Min the well known and conventional finishing steps for forming decorative laminates into floor coverings of cutting the decorative laminate into panels and milling edges on the cut panels intended for joining as shown for example by Moebus wherein only the expected results would be achieved.

Sjoberg et al. further teach the upper decorative and abrasion resistant laminate is formed by providing one or more underlay papers impregnated with phenol-formaldehyde resin,

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providing on the underlay papers one or more décor papers impregnated with melamine-formaldehyde resin, providing on the décor papers one or more overlay sheets impregnated with melamine-formaldehyde resin and hard particles such as silicon oxide, aluminum oxide, silicon carbide, etc. having an average size of 5 - 60  $\mu\text{m}$ , and laminating the papers together under increased heat and pressure to form the upper decorative and abrasion resistant laminate having a thickness of 0.3 - 0.9 mm and a density of 1250 - 1500  $\text{kg/m}^3$  (Page 1, lines 27-28 and Page 2, lines 1-11). Sjöberg et al. teach the dampening foil is a thermoplastic elastomer having an elasticity compression coefficient of 0.8 - 2.0 Mpa, a thickness of 0.1 - 0.5 mm, and a density of 180 - 330  $\text{kg/m}^3$  (Page 2, lines 15-22). Sjöberg et al. teach the upper decorative and abrasion resistant laminate, dampening foil, and carrying core layer are joined by means of melt-glue, heat, and pressure (Page 2, lines 23-27).

Min discloses a method of manufacturing a decorative laminate used for floor coverings comprising providing a carrying core layer, providing a polyvinyl chloride balance layer on the lower side of the core layer, providing an upper decorative and abrasion resistant thermosetting laminate layer on the upper side of the core layer, and then pressing to form the decorative laminate (Figures 2 and 3 and Column 4, lines 40-52). Min teaches the polyvinyl chloride balance layer prevents warping of the decorative laminate and provides improved cushioning (Column 8, lines 32-42). Moebus discloses a method of manufacturing a decorative laminate used for floor coverings comprising providing a carrying core layer, providing an upper decorative and abrasion resistant laminate layer on the upper side of the core layer, pressing to form the decorative laminate, and then cutting the decorative laminate into panels and milling



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edges on the cut panels intended for joining together as a floor covering (Column 1, lines 15-47 of U.S. Patent 6,761,961).

11. Claims 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al., Min, and Moebus as applied to claims 1, 2, 4, 10-12, 30-32, 37-47, and 50-55 above, and further in view of Leukel et al. (U.S. Patent 4,770,916).

Sjoberg et al., Min, and Moebus as applied above teach all of the limitations in claims 33-36 except for a teaching of including a conductive material in the melt-glue. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the melt-glue of Sjoberg et al. as modified by Min and Moebus a conductive material such as carbon black or carbon fiber to impart static dissipating properties to the decorative laminate floor covering as was well known in the art and shown for example by Leukel et al.

Leukel et al. disclose a floor covering including a polyvinyl chloride layer and a glue layer wherein the layers include a conductive material such as carbon black or carbon fiber (conductivity greater than 500 kΩcm) to impart static dissipating properties to the floor covering (Column 3, lines 5-9 and 36-49 and Column 4, lines 59-60).

***Allowable Subject Matter***

12. Claims 13-17, 24-29, 48, and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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13. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a method of manufacturing a decorative laminate wherein the laminate comprises a carrying core, a dampening foil of an elastomer arranged on the upper side of the carrying core, a decorative and abrasion resistant thermosetting laminate layer arranged on the dampening foil, and a balance layer arranged on the lower side of the carrying core, the balance layer formed of a thermoplastic elastomer. Min exemplary of a conventional balance layer teaches the layer is formed of resin impregnated papers or thermoplastic polymers such as polyvinyl chloride with no teaching or suggestion of using thermoplastic elastomer.

### ***Double Patenting***

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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15. Claims 1, 2, 4, 10-12, 30-32, 37-47, 50-52, 54, and 55 are directed to an invention not patentably distinct from claims 1-11 and 13-16 of commonly assigned U.S. Patent 6,893,713.

16. Claims 1, 2, 4, 10-12, 30-32, 37-47, 50-52, 54, and 55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 and 13-16 of U.S. Patent No. 6,893,713 in view of Min and Moebus. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 and 13-16 of U.S. Patent No. 6,893,713 disclose the invention substantially as claimed except for teaching including a balance layer on the lower side of the core layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include on the lower side of the laminate taught by claims 1-11 and 13-16 of U.S. Patent No. 6,893,713 a polymer balance layer, e.g. polyvinyl chloride, as shown by Min to prevent warping of the decorative laminate.

Claims 1-11 and 13-16 of U.S. Patent No. 6,893,713 also do not teach the decorative laminate is cut into panels and provided with edges intended for joining, it being noted claims 1-11 and 13-16 of U.S. Patent No. 6,893,713 do teach the decorative laminate is used for floor coverings. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in claims 1-11 and 13-16 of U.S. Patent No. 6,893,713 as modified by Min the well known and conventional finishing steps for forming decorative laminates into floor coverings of cutting the decorative laminate into panels and milling edges on the cut panels intended for joining as shown for example by Moebus wherein only the expected results would be achieved. Min and Moebus are described above in full detail.

17. Claims 33-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 and 13-16 of U.S. Patent No. 6,893,713, Min,

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and Moebus as applied to claims 1, 2, 4, 10-12, 30-32, 37-47, 50-52, 54, and 55 above, and further in view of Leukel et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 and 13-16 of U.S. Patent No. 6,893,713, Min, and Moebus disclose the invention substantially as claimed except for a teaching of including a conductive material in the melt-glue. Claims 33-36 are rejected in the same manner as that applied above in paragraph 11.

18. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent 6,893,713, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

19. Claims 1, 2, 4, 10-12, 30-32, 37-47, and 50-55 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 5-22 of copending Application No. 11/129,497 in view of in view of Min and Moebus. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 2, and 5-22 of copending Application No. 11/129,497 disclose the invention substantially as claimed except for teaching including a balance layer on the lower side of the core layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include on the lower side of the laminate taught by claims 1, 2, and 5-22 of copending Application No. 11/129,497 a polymer balance layer, e.g. polyvinyl chloride, as shown by Min to prevent warping of the decorative laminate.

Claims 1, 2, and 5-22 of copending Application No. 11/129,497 also do not teach the decorative laminate is cut into panels and provided with edges intended for joining. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in claims 1, 2, and 5-22 of copending Application No. 11/129,497 as modified by Min the well known and conventional finishing steps for forming decorative laminates of this type into floor coverings of cutting the decorative laminate into panels and milling edges on the cut panels intended for joining as shown for example by Moebus wherein only the expected results would be achieved. Min and Moebus are described above in full detail.

This is a provisional obviousness-type double patenting rejection.

20. Claims 33-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 5-22 of copending Application No. 11/129,497, Min, and Moebus as applied to claims 1, 2, 4, 10-12, 30-32, 37-47, and 50-55 above, and further in view of Leukel et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 2, and 5-22 of copending Application No. 11/129,497, Min, and Moebus disclose the invention substantially as claimed

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except for a teaching of including a conductive material in the melt-glue. Claims 33-36 are rejected in the same manner as that applied above in paragraph 11.

This is a provisional obviousness-type double patenting rejection.

### ***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John L. Goff